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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,952	09/04/1998	ATSUSHI INOUE	040301/0539	1055

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EXAMINER

DUONG, DUC T

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 07/30/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/146,952

Applicant(s)

INOUE ET AL.

Examiner

Duc T. Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-24 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,11,13-15,17,18,24,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 10,12,16,19-23 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the amendment filed on May 13, 2003, claims 9-24 and 29-31 remains pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 11, 13, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malkin et al (U.S. Patent 6,061,650).

Regarding to claims 9 and 29, Malkin discloses a mobile computer device capable of carrying out communications while moving over inter-connected networks, the mobile computer device comprising a registration transmission unit (implicitly shown) for transmitting a registration message containing an information on a current location of the mobile computer (col. 6 lines 25-30), from outside a home network of the mobile computer device to a mobile computer management device 22 (Fig. 1) located at the home network, the mobile computer management device having a function for managing the information on the current location of the mobile computer device and transferring packets destined to the mobile computer device to the current location of the mobile computer device (col. 5 lines 66-67 and col. 6 lines 1-2), a user input unit (implicitly shown) for accepting a user input for user authentication (col. 3 lines 39-40),

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and a user-input-based information transmission unit (implicitly shown) for transmitting to the mobile computer management device a response message containing information based on the user input as a user authentication information (col. 4 lines 15-20, noted the authentication information is transmit to the computer management device via RAS), when a challenge message that requests returning of the user authentication information is received from the RAS in response to the registration message (col. 3 lines 35-38).

Malkin fails to teach the challenge message is received from the mobile management device.

However, to arrange the challenge message received from the mobile management device would have been obvious to one of ordinary skilled in the art since such arrangement would enable the RAS to perform remote authentication on behalf of the remote node, without the need for additional software loaded onto the remote node.

Regarding to claim 11, Malkin discloses the user input based information transmission unit transmits the response message containing a one-time password based on a challenge code contained in the challenge message received from the mobile computer management device as the user input based information (col. 3 lines 39-44).

Regarding to claim 13, Malkin discloses the mobile computer, wherein the user input based information transmission unit transmits a password entered by a user at the mobile computer device as the user input based information (col. 3 lines 39-44).

4. Claims 14, 15, 17, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malkin in view of Schroderus et al (U.S. Patent 5,907,804).

Regarding to claims 14, 15, 17, 18, and 30, Malkin discloses a mobile computer device capable of carrying out communications while moving over inter-connected networks, the mobile computer device, a registration message transmission unit (implicitly shown) for transmitting a registration message containing an information on a current location of the mobile computer device (col. 6 lines 25-30), from outside a home network of the mobile computer device to a mobile computer management device 22 (Fig. 1) located at the home network, the mobile computer management device having a function for managing the information on the current location of the mobile computer device and transferring packets destined to the mobile computer device to the current location of the mobile computer device (col. 5 lines 66-67 and col. 6 lines 1-2), and a user-input-based information transmission unit (implicitly shown) for transmitting to the mobile computer management device a user-input-based information to be used for second user authentication at the mobile computer management device (col. 4 lines 15-20, noted the authentication information is transmit to the computer management device via RAS).

Malkin fails to teach for an external interface unit for reading out desired information from an external memory device connected to the mobile computer device, wherein the external memory device stores at least a user information and a network information to be used for communications at a visited site; a user authentication unit for carrying out first user authentication locally at the mobile computer device according to

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the user information stored in the external memory device and a user input; the user authentication unit permits reading from the external memory device through the external interface unit when the first user authentication succeeds (claim 15); the user information stored in the external memory device contains a personal information of a user who uses the mobile computer device, and the user authentication unit judges that the first user authentication succeeds when a user authentication information stored in the mobile computer device in correspondence to the personal information stored in the external memory device coincides with the user input as entered by the user at a time of connecting the external memory device to the mobile computer device (claim 17); and a reading prohibiting unit for prohibiting subsequent reading from an external memory device through the external interface unit when the first user authentication fails for a prescribed number of times consecutively (claim 18).

However, Schroderus discloses a mobile station includes a user interface 505 (external interface unit) for reading out desired information from a memory means 508 (external memory device), wherein the memory means stores at least a user information and a network information (Fig. 3 col. 1 lines 26-33 and col. 9 lines 57-61); a checking means (authentication unit) for checking the validity of said subscriber according to subscriber identification number pin (user input) and information stored in memory means (Fig. 3 col. 9 lines 61-63); the reading of the SIM card is permit once the authentication is succeed (Fig. 1 col. 6 lines 33-42); the user information stored in the external memory device contains a personal information of a user who uses the mobile computer device, and the user authentication unit judges that the first user

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authentication succeeds when a user authentication information stored in the mobile computer device in correspondence to the personal information stored in the external memory device coincides with the user input as entered by the user at a time of connecting the external memory device to the mobile computer device (Fig. 2 col. 7 lines 38-48 and col. 8 lines 48-52); and a blocking means 512 for blocking the reading from the memory means after a predetermined number of fail validation (Fig. 3 col. 9 lines 65-67).

Thus, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to includes the mobile equipment in operation with the SIM card as taught by Schroderus in Malkin's mobile device with the motivation for preventing unauthorized use of mobile device.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malkin and Schroderus in view of Perkins (U.S. Patent 5,159,592).

Regarding to claim 24, Malkin and Schroderus discloses all the limitation with respect to claim 14, except for an internal memory for temporarily storing the desired information read out from the external memory device, wherein the desired information temporarily stored in the internal memory is deleted when communications using the desired information is finished.

However, Perkins discloses a mobile unit 10 maintains its assigned IP address until it is turned off, or until the network session is actively terminated (read on the IP address is temporarily stored so, but deleted after network session termination), sees

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col. 5 lines 6-8. It is well known in the art IP address (desired information) stored in a table or memory.

Thus, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to included a memory for storing temporarily IP address and deleted after network session termination as taught by Perkins in Malkin and Schroderus's mobile device with the motivation for alternative storage and quick access to often use communication data.

Allowable Subject Matter

6. Claims 10, 12, 16, 19-23, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

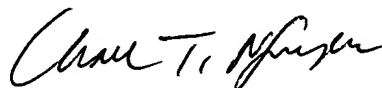
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 703-605-5146. The examiner can normally be reached on M-Th (8:30 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 703-308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

DD
July 27, 2003



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
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